

### REMARKS

The applicants have canceled original claims and submitted new claims. It is believed these amendments obviate all rejections.

In view of the claim amendments, the Examiner's comments concerning the priority date to which the claims are entitled is not relevant.

#### Rejection of claims 1, 8, 9, 12, and 17 under 35 U.S.C. § 102

Claims 1, 8, 9, 12, and 17 were rejected as anticipated by Parrish *et al.* However, Parrish *et al.* does not disclose dsRNA having a strand with a sense region and 3' - and/or 5' -terminal cap. Accordingly, Parrish *et al.* cannot anticipate the present claims.

In view of the foregoing, reconsideration and withdrawal of this rejection is respectfully requested.

#### Rejection of claims 1, 7-11, 14, 15, and 17 under 35 U.S.C. § 102

Claims 1, 7-11, 14, 15, and 17 were rejected as anticipated by Elbashir *et al.* However, Elbashir *et al.* does not disclose dsRNA having strand with a sense region and 3' - and/or 5' -terminal cap. Accordingly, Elbashir *et al.* cannot anticipate the present claims.

In view of the foregoing, reconsideration and withdrawal of this rejection is respectfully requested.

#### Rejection of claims 1-8 and 10-17 under 35 U.S.C. § 102

Claims 1-8 and 10-17 were rejected as anticipate by Matulic-Adamic *et al.* (US 5,998,203; hereinafter "the '203 patent"). The Office Action alleges that the ribozymes of the '203 patent meet all the limitations of the present claims. The applicants respectfully traverse.

The only specific example of an allegedly anticipating disclosure in the '203 set forth in the Office Action is Fig. 3. However, what is disclosed by Matulic-Adamic is a genus of ribozymes of various sizes and structures depending on the values of m, n, o, p, q, and s (*see* and the corresponding discussion of Fig. 3 at column 7, ll. 46 *et seq.*) Furthermore, the ribozymes in Fig. 3 of the '203 patent may also be formed from a single strand ( $q \neq 0$ ) or from two strands ( $q = 0$ ). As described in col. 10,  $1 \leq m \leq 20$  or more,  $1 \leq n \leq 4$ ,  $0 \leq o \leq$  any number (*e.g.*, 20) or more,  $0 \leq p \leq$  any number (*e.g.*, 20),  $q = 0$  or  $\geq 2$ , and s is undefined. It is only when  $q = 0$ ,  $p + s + n + o \leq 6$ , and

p+m≤11 do the disclosed ribozymes have two strands, each in the range of 19-29 nucleotides in length, as presently claimed. These molecules also have 4 or more nucleotide long internal loop structures that are not required for instantly claimed siNA molecules.

Thus, the '203 patent discloses a genus of nucleic acids in which the claimed nucleic acids consists of a relatively small number of species. There are no pointers in the '203 patent to any nucleic acids falling within the scope of the present claims. It is now well settled that under such circumstances the genus does anticipate the species.

In view of the foregoing, therefore, the '203 patent cannot anticipate the present claims. Reconsideration and withdrawal of this rejection is respectfully requested.

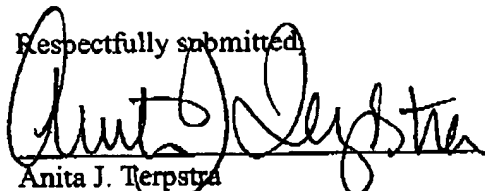
**Provisional double-patenting rejections**

The amendments to the claims obviate the provisional double-patenting rejections. Accordingly, reconsideration and withdrawal of these rejections is respectfully requested.

If there are any questions or comments regarding this Response or application, the Examiner is encouraged to contact the undersigned attorney as indicated below.

Date: July 20, 2005

Respectfully submitted,



Anita J. Terpstra  
Registration No. 47,132

Telephone: 312-913-0001  
Facsimile: 312-913-0002

**McDonnell Boehnen Hulbert & Berghoff LLP**  
300 South Wacker Drive  
Chicago, IL 60606